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DEC 21 2006

Atty Dkt. No.: YAMA-009
USSN: 10/759,788

REMARKS

In view of the following remarks, the Examiner is requested to allow Claims 1, 3-8, 10, 11, 13, 14 and 16-20, the only claims pending and under examination in this application following entry of the above amendment.

Claim 1 has been amended to incorporate the elements recited in Claim 2. Consequently, Claim 2 has been cancelled. Claims 3, 4, 6 and 17 have been amended to clarify the claim language. Support for these amendments may be found throughout the specification and claims as originally filed. Accordingly, no new matter has been added. As no new matter has been added by way of this amendment, entry thereof by the Examiner is respectfully requested.

As an initial matter the Examiner is thanked for the telephonic interview conducted on December 15, 2006, during which interview the present rejections of the claims were discussed.

Claim Rejections - 35 U.S.C. § 112, second paragraph

Claims 4, 6 and 17 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claims 4, 6 and 17 have been amended. Accordingly, in view of the amendments to Claims 4, 6 and 17 this rejection may be withdrawn.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 2, 5-8, 10, 11, 13 and 14-20 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Yamashita (5,549,729).

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According to the M.P.E.P. a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Additionally, the identical invention must be shown in as complete detail as is contained in the claim. See M.P.E.P. § 2131.

Claim 1 is directed to a pesticide composition. An element of the composition of Claim 1 is a non-naturally occurring pesticide.

The Office asserts that Yamashita '729 anticipates Claim 1 and the claims dependent thereon. The Office asserts that the '729 patent discloses entopathogenic pesticides. In support of this assertion the Office points to the Gram-positive bacteria *Bacillus thuringiensis* recited in Example 9 of the '729 patent. The Applicant, however, contends that *Bacillus thuringiensis* is a naturally occurring bacterium. Accordingly, because *Bacillus thuringiensis* is naturally occurring, the '729 patent does not teach a non-naturally occurring pesticide as recited in Claim 1 as amended. Therefore, because the '729 patent does not teach every element of the rejected claims it fails to anticipate the claimed invention. Consequently, the Applicant therefore respectfully requests the 35 U.S.C. § 102(b) rejection of Claims 1, 2, 5-8, 10, 11, 13 and 14-20 be withdrawn.

Claims 1-8, 10, 11, 13, 14 and 16-20 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Summers (3,514,516) in view of Yamashita (5,549,729).

According to the M.P.E.P. § 706.02 (j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the

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prior art reference (or references when combined) must teach or suggest all the claim limitations.

Claim 1 is directed to a pesticide composition that includes a non-naturally occurring pesticide, a carbon-skeleton energy component, a macronutrient, a micronutrient and a vitamin/cofactor component.

The Office asserts that Summers discloses a nematocidal and fungicidal composition. The Office acknowledges that Summers does not teach a pesticide composition that also includes a carbon-skeleton energy component, a macronutrient, a micronutrient and a vitamin/cofactor component. Accordingly, the Office relies upon the '729 patent to remedy the deficiencies of Summers.

The Applicant, however, respectfully disagrees and contends that Summers cannot be combined with the '729 patent because there is no motivation to combine the references in the manner suggested.

As a motivation to combine the references the Office asserts that the '729 patent discloses the use of a soil amendment for nematode control. However, the Applicant contends that the Office is mischaracterizing the '729 patent.

In support of its assertion the Office directs the Applicant to Example 10. As disclosed in the '729 patent, Example 10 is not directed to controlling the adverse effects of nematodes. Rather, Example 10 is directed to describing the effects on vegetative growth produced by contacting sugar beets and tomatoes with the disclosed soil amendment. Although the sugar beets and tomatoes are grown in soil that includes nematodes, the disclosed composition is in no way described as having any effect on the nematodes present in the soil. Rather, the effect of the composition is described solely in terms of its ability to enhance vegetative growth of the sugar beets and tomatoes. Accordingly, contrary to the assertion of the Office, the '729 patent does not

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disclose a soil amendment for the control of nematodes.

Therefore, in view of the above, the cited reference does not stand for the proposition for which it was cited by the Office. Consequently, because the cited reference does not stand for the proposition for which it was cited by the Office, there is no motivation to combine the references in the manner suggested. Hence, a *prima facie* case of obviousness has not been established because there is no motivation to combine the references in the manner suggested. Accordingly, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1-8, 10, 11, 13, 14 and 16-20 be withdrawn.

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The Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number YAMA-009.

Respectfully submitted,
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